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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,780	08/18/2000	Jacques Dumas	BAYER8C1	7350

23599 7590 05/20/2003

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EXAMINER:

ROBINSON, BINTA M

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 05/20/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/640,780

Applicant(s)

DUMAS ET AL.

Examiner

Binta M. Robinson

Art Unit

1625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE:

The applicant traverses the restriction requirement alleging that the examiner has not presented evidence that the search and examination of groups I and II could not take place simultaneously. The applicant also alleges that no classes and subclasses for the subject matter of group II has been identified. The examiner is not required to show that the groups I and II could be searched simultaneously. The applicant is only entitled to a single, independent invention and the examiner has restricted the application to a single, independent invention. If the restriction was not applied, there would be a serious burden, because the rings which B can be such as phenyl, pyrazinyl, pyridazinyl, quinolinyl, furyl rings are classified in multiple classes of 546, 548, and 549. This is why groups I and II could not be searched simultaneously. Compounds in Group II can be classified in many classes and subclasses such as 546/329.

112, first paragraph rejection The applicant asserts that there is adequate disclosure within the specification

for one skilled in the art to make the compounds recited in the claims and use them in accordance with the methods defined, without undue experimentation and that the burden is on the examiner to show otherwise. The applicant also alleges that the 397 specific compounds identified in the tables of the specification include structures other than phenyl or pyridyl. However, the examiner notes that these compounds do not include structures in which B is other than phenyl or pyridyl. The examiner does not see where the compounds as listed in tables 1, 2.3, 3, 5.5, and 5 have B moieties equal to rings other than phenyl or pyridyl. The examiner has recited the Wands factors. The claims are so broad that more than routine experimentation is required to place the invention in the possession of the public. The applicant does not provide working examples or test data for the compounds where B can equal all of the other rings claimed. What cancers, cell lines, what specific tests were performed to show that cancerous cell growth has been reduced in scope? Without the results of cellular assays and in vivo assays for any of the claimed compounds, undue experimentation would be required to make or use the invention based on the content of the disclosure due to the breadth of the claims, the level of predictability in the art of the invention, and the poor amount of direction provided by the inventor.

BMA
4/22/03

Alan L. Rotman
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